

Appl. No. 09/819,194
Amdt. E dated June 29, 2004
Reply to Office action of April 22, 2004

REMARKS

Summarizing this amendment, claim 4 has been amended, while claims 1-3, 5-12 and 19-29 remain unchanged. Thus claims 1-12 and 19-29 are again presented for examination.

In the Office action of October 22, 2003, the examiner allowed claims 20-24 and 26-29 and indicated that claim 25 would be allowed if amended to remove an ambiguity. Applicant complied and amended some of the remaining claims with the examiner's comments in mind. Now the examiner has rejected all of the claims – including claims 24-29 – contending that applicant's portable facility as set forth in those claims is obvious within the meaning of 35 USC 103.

The new references are no more pertinent than the old ones. The Fogal patent (U.S. patent 5,226,771) discloses a machine for refinishing the rims on which the rubber tires of automotive vehicles are mounted. The Sequin patent (U.S. patent 6,168,676) concerns a railcar provided with equipment for repairing cracks in steel railroad tracks. The Crisp patent (U.S. patent 5,876,018) relates to a jack for elevating a railcar so that an entire axle set may be removed and replaced. The Bellas patent (U.S. patent 3,308,845) pertains to a mobile facility for servicing automobiles.

According to MPEP 2142, the examiner bears the initial burden of supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie

case, the applicant is under no obligation to submit evidence of unobviousness. There must be a logical reason apparent from the record that would justify combining the references. A motivation to combine the references must exist. The four references relied upon by the examiner and the discussion of them in the Office action fall far short of producing a prima facie case of obviousness.

In the first place, the four references themselves contain nothing which would suggest that they can be combined, much less in the manner that the examiner seeks to combine them. For example, who would attempt to combine teachings from a welding machine for repairing railroad track (Seguin) with a machine for refinishing rims for road wheels (Fogul) or either of the foregoing machines with a jack for elevating railcars (Crisp) or with a mobile service station into which automobiles are driven for garage-type repairs (Bellas)? The four references are just too divergent to be logically combined. Within the cited prior art a basis must exist for combining the references, and here the four references relied upon by the examiner are totally devoid of any basis. While it is impermissible to rely on hindsight to combine references, here even hindsight will not suffice. No motivation whatsoever exists for combining the four references.

Apart from that, the Crisp patent does not disclose that which the examiner contends it discloses. Where does Crisp teach spare races, rolling elements, and cages? After all, the Crisp patent addresses defects in wheels, not bearings

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In view of the foregoing, withdrawal of the rejection and allowance of claims 1-12
and 19-29 are respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Edward A. Boeschstein". The signature is fluid and cursive, with the first name "Edward" being more prominent.

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